

REMARKS

Prior to this response, claims 13, 33-50, 57-66, and 76-83 were pending in the application. Claim 34 has been amended in the above amendments. No claims have been canceled or added. Accordingly, claims 13, 33-50, 57-66, and 76-83, of which claims 13, 76, and 83 are independent, are still pending in the application.

Claim objections:

Paragraph 3 of the Action objects to claim 34 because “associate” was mistakenly spelled “associated.” Applicant has amended claim 34 as suggest to correct this informality. Accordingly, Applicant respectfully requests withdrawal of the objection.

Claim Rejections Under §112:

Paragraph 4 of the Action purports to reject claim 33 under 35 U.S.C. 112; however, paragraph 4 fails to state a rejection. Rather, paragraph 4 merely requests additional information. Accordingly, Applicant does not view paragraph 4 as a rejection but will provide the information requested.

To ensure that the background is clear, claim 13 is directed to a system in which a calling party uses their communication device, i.e., telephone, to make a call. As is well known in the telephone example, the calling party’s telephone will be connected with a switch. The calling party will then place a call by dialing a number associated with a called party. In the present application, the call is an incoming communication, i.e., a communication coming into the switch. Accordingly, the calling party, or the calling party’s telephone, is a source of the incoming communication and the called party is a destination of the incoming communication.

The switch will receive the dialed number and route the call to the destination. During the process, the switch will send certain call routing signals to both the source and destination. These signals are well known in the telephone example. For example, when a calling party first picks up the telephone, the switch routes a dial tone signal to the calling party's telephone. When the calling party dials the number, the switch routes a ring back signal to the calling party's telephone. Importantly, it is well known that the ring back signal comprises a series of short ring tones. The dial tones lets the calling party know that they have a connection with the switch, the ring back signal lets the calling party know that the switch is trying to connect them with the destination. This is all described with respect to figures 1 and 2 in the present application.

In the system claimed in claim13, and the claims dependent therefrom, an advertisement database is included with or connected to the switch. The system is configured to route advertisements or messages to the calling or called party, i.e., the source or destination. In certain embodiments, an advertisement or message can replace the normal call processing signals such as the ring back signal or dial tone, and in a particular embodiment, very short advertisements can replace each individual ring tone in the ring back signal. In other embodiments, the advertisements or messages can be included in addition to the normal call processing signals. (See, e.g., page 7, lines 25-27, et seq.).

Paragraph 4 asks when would an advertisement replace the dial tone as claimed in claim 33? In certain embodiments, when the calling party first picks up the telephone, they will hear an advertisement instead of a dial tone to let them know that they are connected to the switch. In other embodiments, the advertisement can precede the dial tone. (See page 7, lines 25-32).

Paragraph 4 also asks when does the caller dial the destination? In certain embodiments, the caller can dial the destination at any point after they have picked up the telephone.

Paragraph 4 also states that it is not understood what advertisement would play to the destination, since the destination is unknown. The system does not need to know the identity of the called party, i.e., destination, in order to route an advertisement to the destination. The advertisement routed to the destination could be randomly selected, or it can be the same as the one sent to the called party. (See, e.g., page 9, lines 9-11). Although, it must be pointed out that the destination is known, since it is identified by the dialed number.

Paragraph 5 of the Action again purports to reject claim 1 (by which Applicant assumes claim 13 is meant); however, paragraph 5 really appears to be another request for information. First, claim 5 indicates that the relationship between several terms appears to be unclear. Applicant respectfully disagrees. The present application makes clear, for example, that in certain embodiments a user can subscribe to a service that will provide advertisements to the user when the user, e.g., makes telephone calls. Once the user has subscribed, they are a subscriber. In certain embodiments, a subscriber will receive advertisements or messages that are associated with, or specific to that subscriber. In other embodiments, or instances, the subscriber will receive advertisements or messages created by a third party. (See page 4, lines 6-10). Thus, the terms “subscriber,” “third party,” and “user” and their relationship is clear when claim 13 is read in light of the specification.

As described above, the term “communication source” refers to the source of an incoming communication, and the term “destination” refers to the destination of the incoming communication. Accordingly, these terms are also clear when claim 13 is read in light of the specification.

Paragraph 5 also asks whose language, geography, etc., is relevant when associating an advertisement based on these factors. The answer is that the claim as written is not limited in this respect. For example, the language could be the language most commonly spoken in the region where the call is originated. In other embodiments, if the caller is a subscriber, they can indicate their language preference. Examples of each factor and how they are use dare described in the specification. Accordingly, Applicant believes that all of the options covered by claim 13 are clear when claim 13 is read in light of the specification.

Applicant, believes that the information requested in paragraphs 4 and 5 has been provided and therefore request withdrawal of any rejections under 35 U.S.C. 112.

Claim Rejections Under §103:

Paragraph 3 of the Action rejects claims 13, 33-43, 49-50, 57-59, 65-66, 76-77, and 83 under 35 U.S.C. §103(a) as being unpatentable over Carrier (U.S. Patent 5,195,126) in view of Gregorek (U.S. Patent 5,557,658). Applicant respectfully traverses this rejection for at least the reasons stated below.

The Action maintains the exact same rejection as put forth in the previous Action, which Applicant has already traversed. Accordingly, Applicant has put forth the same response below; however, Applicant will address the response to Applicant's Arguments contained in the present Action here to further clarify Applicant's response.

With respect to Applicant's previous response to the rejection of claim 13, the Action states that it is unclear how the destinations in Carrier differ from the destination in the present application and claimed in claim 13. As mentioned above, certain embodiments of the present invention are directed to systems in which the switch plays an advertisement or message to a destination of an incoming communication, prior to connecting the destination with the calling

party. A destination is defined, at least in certain embodiments, as the destination of the communication coming into a switch, i.e., the destination identified by the number dialed.

Contrary to the position taken in the Action, Carrier does not teach associating an advertisement or message with a destination so defined. In Carrier, the calling party places a call to 911. Thus, the destination is the emergency center associated with the 911 number. To anticipate claim 13, the system in Carrier would need to teach playing a message to the emergency technician answering the 911 call. But this is not what Carrier teaches. Carrier teaches that the system is configured to place calls to other numbers and play messages to those numbers. These other numbers are not destinations of the original call. Therefore, they are not destination of an incoming communication as required by claim 13.

Accordingly, Carrier does not teach “A processor coupled with the advertisement database, the *processor configured to selectively associate*, based on one or more factors selected from the group consisting of user preferences, language, communication source, communication type, time of day, communication destination, and geography, *at least one advertisement in the advertisement database with a destination of an incoming communication . . .*,” as required by claim 13.

With respect to Applicant’s previous response to the rejection of claim 76 and 83, the Action states that the claims do not sufficiently recite replacing the rings of a ring back signals with a series of short advertisements as opposed to replacing the entire ring back signal. Applicant respectfully disagrees. For example, claim 76 recites “. . . cause the plurality of short advertisement associated with the source to replace the rings of a ring back signal.” Accordingly, Applicant asserts that claim cites sufficient detail.

The Action further states that the ring back signal is also short and that an advertisement that replaced the ring back signal would therefore be short. Applicant is unclear as to the point of this statement other than the fact it apparently admits Gregorek teaches replacing the ring back signal and not the individual ring tones. Applicant is not arguing that a ring back signal isn't short. Applicant is arguing that replacing the ring back signal is not the same as replacing the ring tones themselves, which it clearly is not. And while a ring back signal may be short, it is clearly not as short as the ring tones. Thus, a continuous message of 5-30 seconds as taught in Gregorek clearly would not be sufficient to achieve the invention as claimed in claims 76 and 83.

Applicant's previous responses to the actual rejections contained in the latest Action follow.

In response to a previous rejection of claim 13, Applicant pointed out that Gregorek does not teach associating an advertisement with the destination of a call. The current Action now admits that Gregorek does not teach this feature; however the current Action states that Carrier teaches associating an emergency message with a destination of an incoming communication. Applicant respectfully disagrees.

On page 5, lines 21-22, the description states "... the called part is the destination 112 of incoming communication 118." Thus, in order for Carrier to make up for the deficiencies of Gregorek, Carrier must teach associating an advertisement with the destination, i.e., the party called, of an emergency communication, e.g., a 911 call. Carrier does not teach associating an advertisement with the called party, i.e., the 911 service center. Rather, Carrier expressly states that the processing of the 911 call proceeds as normal (see Col. 4, lines 53-54). Accordingly, Carrier does not teach associating an advertisement with the destination of the incoming communication as required by claim 13.

Carrier does teach that the system, upon receipt of the incoming emergency communication, will also dial other predetermined destinations and play a personal message. But these other destination dialed by the system are not a destination as defined in the present application and claimed in claim 13, because these destination are not the destination of the incoming communication, which is processed normally. Rather, these destinations are destinations dialed by the system.

Further, the rejection as to claim 13 must fail, because the Action fails to provide a proper motive to combine Carrier with Gregorek. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." See MPEP §706.02(j).

In this instance, the references used to reject claim 13 fail to meet all three of these requirements. First, the Action fails to establish a *prima facie* case of obviousness, because the references fail to disclose each and every element of claim 13 as described above. In addition, however, the Action fails to establish a *prima facie* case of obviousness, because the Action fails to provide a proper motivation to combine the two references. In attempting to provide this motivation, the Action states that "[i]t would have been beneficial to be able to productively occupy the time when both the calling and called parties are on the line, and to avoid having both

parties listen to a meaningless or annoying busy signal, a ring back signal, or wait idly while one of the parties (sic) station receives another call or processing information.”

This statement fails to provide the proper motivation to combine for several reasons. First, it is inaccurate. While call processing signals may be annoying, they are un-questionably *not* meaningless. They are in fact necessary to the successful completion of calls as is well understood by one of skill in the art. Their existence and use alone are evidence enough of their necessity and everyone who has used a telephone understands their meaning. Accordingly, the statement that “[i]t would have been beneficial to be able to productively occupy the time when both the calling and called parties are on the line, and to avoid having both parties listen to a meaningless . . .” is inaccurate and cannot be used to form the basis of a *prima facie* case of obviousness.

Second, the statement does not provide the substantial evidence based on the references themselves, necessary to support a *prima facie* case of obviousness. As noted above, “[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” *See* MPEP §706.02(j). Further, each finding of fact upon which a conclusion of obviousness is based must be supported by substantial evidence and, in particular the conclusion that the prior art suggests or motivates the modification of a prior art reference must be based on findings supported by substantial evidence. *In re Kotzab*, 217 F. 3d 1365, 1370-71 (Fed. Cir. 2000). Hence, a *prima facie* case of obviousness cannot be made out by merely asserting that modifications to the prior art are “well within the ordinary skill of the art.” *Ex Parte Leavengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Accordingly, Applicant asserts that the Action fails to make out a *prima facie* case of obviousness, because it fails to provide the substantial evidence in support of the conclusion that *the cited references* teach a motivation to modify the teachings of Carrier with the teachings of Gregorek. Or stated another way, the statement “[i]t would have been beneficial to be able to productively occupy the time when both the calling and called parties are on the line, and to avoid having both parties listen to a meaningless . . .” is not based on the references being cited and appears at best to be based on hindsight gleaned from the teachings of the present application.

Accordingly, Applicant respectfully request withdrawal of the rejection as to claim 13, because Carrier and Gregorek, alone or in combination, fail to render claim 13 unpatentable. Further, Applicant respectfully request withdrawal of the rejection as to claims 33-43, 49-50, 57-59, and 65-66 because they depend from claim 13 which is itself allowable over the art of record.

Applicant respectfully requests withdrawal of the rejection as to claim 34 for the additional reason that Carrier and Gregork, alone or in combination, fail to teach, suggest, or disclose replacing the rings of the ring back signal with short advertisements. In a previous Action, claim 34 was rejected based on Gregorek. Applicant pointed out, however, that Gregorek failed to teach this limitation.

Specifically Applicant pointed out that Gregorek teaches replacing the entire ringback signal with one continuous message that is 5 – 30 seconds long (see Col. 11, lines 18-25). This is not the same as replacing the individual rings of the ringback signal with a short advertisement as described in the present application (see page 8, lines 7-9) and claimed in claim 34. As explained in the present application, a ringback signal comprises a plurality of short rings (see page 8, lines 7-9). It should be well understood that these rings are very short, i.e., a fraction of a

second. Thus, unlike Gregorek, the present application teaches that very short advertisements can be used in place of the rings of the ringback signal. As noted in the present application, this is different than replacing the entire ringback signal with a continuous advertisement (see page 8, lines 27-30).

The present Action puts forth no new grounds for rejecting claim 34. In particular, the Action does not assert that Carrier teaches the additional limitations of claim 34. Accordingly, Applicant asserts that claim 34 is allowable over the art of record for the reasons stated previously and restated above. Applicant therefore respectfully requests withdrawal of the rejection as to claim 34 for at least this additional reason.

In addition, Applicant respectfully requests withdrawal of the rejection as to claims 37 and 58 for the additional reason that the Action fails to present a *prima facie* case of obviousness as to the additional limitations found in these claims. As previously stated, in order to support a *prima facie* case of obviousness, the references must teach each and every element as well as a motivation to combine the references. Claims 37 and 58 require that the “. . . advertisement associated with the destination . . . be routed to the destination when the destination goes off hook in response to the incoming communication.” Thus, in order to support a *prima facie* case of obviousness, the references, alone or in combination, must teach this limitation.

The Action admits that Carrier does not teach this limitation; therefore, Carrier alone cannot render the claims unpatentable. Thus, in order to support a *prima facie* case of obviousness, Gregorek must teach this limitation; however, as applicant pointed out in Applicants previous response, Gregorek does not teach associating an advertisement with the destination. The present Action does not argue this point, but rather cites Carrier for teaching associating an advertisement with the destination. Accordingly, Gregorek admittedly does not

teach associating an advertisement with the destination and cannot therefore teach that the “. . . advertisement associated with the destination . . . be routed to the destination when the destination goes off hook in response to the incoming communication.” Gregorek cannot, therefore, make up for the deficiencies of Carrier in this respect.

Accordingly, the Action fails to establish a *prima facie* case of obviousness regarding claims 37 and 58, because the references cited fail to teach each and every element of claims 37 and 58. Moreover, the Action fails to provide the necessary motivation to combine the references required to establish a *prima facie* case of obviousness. First, neither reference teaches the addition limitations of claims 37 and 58, therefore they cannot possibly provide a motivation to combine the two references in order to achieve limitations that are not contained in either reference. Second, the statement that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Carrier’s emergency alert system to alert or route advertisements information when the destination goes off hook in order to have two ways (sic) routing advertisement system,” fails to make out a *prima facie* case of obviousness, because it fails to provide the substantial evidence in support of the conclusion that *the cited references* teach a motivation to modify the teachings of Carrier with the teachings of Gregorek and appears at best to be based on hindsight gleaned from the teachings of the present application.

Applicant therefore respectfully requests withdrawal of the rejection as to claims 37 and 58 for at least these additional reasons.

Applicant respectfully requests withdrawal of the rejection as to claim 38 for the additional reason that Carrier and Gregork, alone or in combination, fail to teach, suggest, or disclose causing “. . . the advertisement associated with the source to be routed to the source

when the advertisement associated with the destination is routed to the destination.” The Action merely states that Gregorek “teaches the advertisement associated with the source to be routed to the source.” But this statement is clearly insufficient to establish that either Carrier or Gregorek, alone or in combination, teach, suggest or disclose “. . . the advertisement associated with the source to be routed to the source when the advertisement associated with the destination is routed to the destination.”

Applicant asserts that neither reference teaches this limitation nor can the references support a *prima facie* case of obviousness for reasons similar to those asserted above with respect to claims 37 and 58. Applicant therefore respectfully requests withdrawal of the rejection as to claim 38 for at least these additional reasons.

Applicant respectfully requests withdrawal of the rejection as to claims 50 and 66 for the additional reason that Carrier and Gregork, alone or in combination, fail to teach, suggest, or disclose that “. . . the database is interfaced with the Internet, and wherein the user can access the database to update the user preferences over the Internet.” The Action states that the claims are rejected for the same reasons discussed with respect to claim 31. Claim 31 has been cancelled, so there appears to be no grounds presented for the rejection. In a previous Action, claim 31 was rejected because Gregorek stated that a telephone or “other device” can be used to establish a connection with the switch in order to access the system; however, Gregorek makes no reference to the Internet, nor does Carrier. Applicant therefore respectfully requests withdrawal of the rejection as to claims 50 and 66 for at least these additional reasons.

With respect to claims 76 and 83, the Action states that these claims are rejected for the same reasons discussed with respect to claims 13, 34, and 57. Accordingly, Applicant asserts that claims 76 and 83 are allowable for at least the reasons stated above with respect to claims

13, 34, and 57. Specifically, Applicant reiterates that neither Carrier or Gregorek teach, suggest, or disclose replacing the ring tones of the ring back signal with short advertisements. Accordingly, neither Carrier nor Gregorek, alone or in combination, can render claims 76 and 83 unpatentable. Accordingly, Applicant respectfully request withdrawal of the rejection as to claims 76 and 83. Further, Applicant respectfully request withdrawal of the rejection as to claim 77 because it depends from claim 76, which is itself allowable over the art of record.

Paragraph 4 of the Action rejects claims 44-48, 60-64, and 78-82 under 35 U.S.C. §103(a) as being unpatentable over Carrier (U.S. Patent 5,195,126) in view of Gregorek (U.S. Patent 5,557,658). Claims 44-48, 60-64, and 78-82 ultimately depend from claims 13 and 76, which are allowable for at least the reasons stated above. Therefore, claims 44-48, 60-64, and 78-82 are allowable for at least these same reason unless Kung can make up for the deficiencies of Carrier and Gregorek, which it cannot. Applicant therefore respectfully request withdrawal of the rejection as to claims 44-48, 60-64, and 78-82 because they are allowable for at least the reasons stated above with respect to claims 13 and 76.

In paragraph 5, the Action addresses Applicant's previous argument that Gregorek does not teach replacing the ring tones of the ring back signal with short advertisement, but rather that Gregorek teaches replacing the entire ring back signal with one long message that is 5-30 seconds long. This argument is relevant to claims 34, 76, and 83 and any claims that depend therefrom. The Action does not attempt to refute this position, but rather states that "[t]his is irrelevant to the claimed invention." Applicant must respectfully disagree.

First, as noted, the limitations at issue are expressly contained in three separate claims, two of which (claims 76 and 83) are independent claims. Thus, Applicant does not understand

how the Action can state that these limitations are irrelevant, since this is clearly not the case. The limitations are quite relevant.

Second, it is an unquestioned tenant of patent law that in order for a reference to render a claim unpatentable, it must teach each and every element of the invention as claimed. Moreover, “the identical invention must be shown in as complete detail as contained in the . . . claim.” (*See* MPEP §2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Thus, in order to render claims 34, 76 and 83 unpatentable, either Gregorek or Carrier, alone or in combination, must teach that the rings of the ring back signal are replaced with short advertisements.

Applicant asserts that Carrier does not teach this limitation, and the Action makes no assertion to the contrary. Applicant has previously asserted that Gregorek does not teach this limitation. The above statement does not refute this position, but rather tries to overcome it by stating that it is not relevant to the claimed inventions, which again is clearly not the case. Accordingly, Applicant asserts that the statement of paragraph 5 admits that this limitation is not met by Gregorek, but attempts to provide an improper basis for an anticipation or obviousness rejection. Because the statement is not a proper basis to rejection the claims as being anticipated or obvious, and for the reasons stated above, Applicant asserts that Carrier and Gregorek alone or in combination, cannot render claims 34, 76 and 83 unpatentable. Applicant, therefore, respectfully asserts that claims 34, 76, 83, and any claims that depend therefrom are allowable over the art of record.

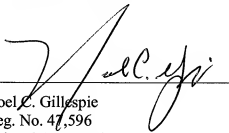
CONCLUSION

Applicant believes that given the above amendments and remarks, the claims are now in condition for allowance and such is respectfully requested. No new claim fees are believed to be necessitated by this response. The Examiner is requested to charge any additional fees that may due with this response to deposit account 13-048.

Respectfully submitted,

Date: 5/18/06

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